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McGuire Woods LLP
1750 Tysons Boulevard Suite 1800
McLean, VA 22102

EXAMINER

VU, NGOC YEN T

ART UNIT PAPER NUMBER

2612

26

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/025,862

Applicant(s)

TANAKA ET AL.

Examiner

Ngoc-Yen T. Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 05/26/2004 have been fully considered but they are not persuasive.

With respect to the Wakabayashi reference (JP #8-294030), the Applicants argue that Wakabayashi fails to teach a control unit which prevents the combination unit from combining the digital electronic signal with the electronic signal when the specific phone number of the remote device coincides with the phone number designated by the designating unit. The Examiner respectfully disagrees. Wakabayashi specifically teaches that the portable telephone with an integrated video camera can be used selectively as a hands-free telephone set (Fig. 1) or as a handset-type telephone set (Figs. 5, 6 and 7). Wakabayashi also teaches a designating unit (10) which designates a remote device in the wireless telephone network with a specific phone number thereof (page 6, para. 0010; page 7, para. 0013). Wakabayashi further teaches that when the portable telephone with the integrated video camera is used as a handset-type telephone set (when the specific phone number of the remote device coincides with the phone number designated by the designating unit) (see Figs. 5, 6 and 7), power of the camera section is automatically cut off (page 8, para. 0017) (there is no digital electronic signal outputted from the camera section).

In view of the above, the Examiner believes that the broadest interpretation of the present claimed invention does in fact read on the cited references for at least the reasons

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discussed above and as stated in the detail Office Action as follows. This Office action is now made final.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-7, 10-14, 16 and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wakabayashi (JP8-294030) in view of Harris et al. (US #6,009,336).

Regarding claim 1, Wakabayashi teaches a digital still camera (1) capable of telecommunication comprising:

a first converting unit (camera 20) which converts an optical image into a digital electronic signal indicative of a still image;

a second converting unit (microphone 22) which converts sound into an electronic signal;

a receiver which receives an electromagnetic signal transmitted through a wireless telephone system network; a modifying unit which modifies said electromagnetic signal into a digital electronic signal indicative of a still image (see Figs. 1, 3 and 4); and

a display unit (8) which alternatively displays a still image based on the digital electronic signal from the converting unit or from the modifying unit,

a combination unit which combines the digital electronic signal and the electronic signal to form a combination signal (see Figs. 1, 3 and 4);

a designating unit (10) which designates a remote device in the wireless telephone network with a specific phone number thereof, and

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a control unit which prevents the combination unit from combining the digital electronic signal with the electronic signal when the specific phone number of the remote device coincides with the phone number designated by the designating unit (see Figs. 5, 6 and 7).

Claim 1 differs from Wakabayashi in that the claim further requires a storage unit which stores at least one phone number. However, the limitation is well known in the art as shown in Harris '336. In the same field of endeavor, Harris '336 teaches a digital camera capable of telecommunication comprising a memory (Fig. 1, memory 139) which stores at least one specific telephone number (col. 9 lines 26-43; col. 10 line 47 - col. 11 line 7). In light of the teaching from Harris, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the digital camera taught in Wakabayashi with a storage unit for storing phone numbers so as to allow the user to access desired phone numbers in an expedite manner.

As to claim 2, Wakabayashi, as modified by Harris '336, teaches a memory (Fig. 1, image memory 153) which alternatively stores the digital electronic signal from the converting device (col. 4 lines 23-60; col. 12 lines 5-24) or from the modifying unit (col. 4 lines 30-33, lines 51-60).

As to claim 3, Wakabayashi teaches that the display unit (8) includes a reflection type color liquid crystal display device.

As to claim 4, Wakabayashi, as modified by Harris '336, teaches an activation unit for automatically activating the receiver in response to an electromagnetic signal transmitted through the wireless telephone system network and identifying the digital still camera (Harris, col. 3 line 41 - col. 4 line 3; col. 9 lines 6-65).

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As to claim 5, Wakabayashi teaches a speaker (speaker 12) for generating an audio signal in response to the electromagnetic signal transmitted through the wireless telephone system and received by the receiver.

As to claim 6, Wakabayashi, as modified by Harris, teaches a display control unit which controls the display unit, in response to the electromagnetic signal received by the receiver, to indicate whether the received electromagnetic signal contains a still image signal or an audio signal (Wakabayashi, Figs. 1-8) (Harris, col. 3 line 41 - col. 4 line 50; col. 9 lines 17-65).

As to claim 7, Wakabayashi, as modified by Harris, teaches a switching unit that switches between device a first mode of generating the audio signal via the speaker in response to the electromagnetic signal received by the receiver to (Figs. 5-7), and a second mode of displaying the image on the displaying device display unit in response to the electromagnetic signal received by the receiver (Figs. 1, 3 and 4).

As to claim 10, Wakabayashi teaches a manual control unit which allows an operator to manually control the switching unit (Figs. 1-7).

Regarding claim 11, Wakabayashi teaches a digital still camera (1) capable of telecommunication comprising:

- a converting unit (camera 20) which converts an optical image into a digital electromagnetic signal indicative of a still image;

- a microphone (22) which converts sound into an electronic signal;

- a combination unit which combines the digital electromagnetic signal and the electronic signal to form a combination signal (Figs. 1, 3 and 4);

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a designation unit (10) which designates a remote device in a wireless telephone network with a specific number thereof,

a control unit which prevents the combination unit from combining the digital electronic signal with the electric signal when the specific phone number of the remote device coincides with the phone number designated by the designation unit (Figs. 5-7);

a receiver which receives an electromagnetic signal transmitted through the a wireless telephone network (Figs. 1, 3 and 4);

a modifying unit which modifies said electromagnetic signal into a digital electronic signal indicative of a still image (Figs. 1, 3 and 4);

a display unit (8) which alternatively displays a still image on the basis of based on the digital electronic signal from the converting unit or from the modifying unit;

a speaker (12/21) for generating an audio signal from the electromagnetic signal transmitted through the wireless telephone system network and received by the receiver; and

a first extracting unit which extracts an audio signal component from an electromagnetic signal containing both a still image signal and an audio signal, and a second extracting unit which extracts a still image signal component from the electromagnetic signal containing both a still image signal and an audio signal, whereby the display unit is capable of displaying the still image while the audio signal is being generated from the speaker (Figs. 1 3 and 4).

Claim 11 differs from Wakabayashi in that the claim further requires a storage unit which stores at least one phone number. However, the limitation is well known in the art as shown in Harris '336. In the same field of endeavor, Harris '336 teaches a

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digital camera capable of telecommunication comprising a memory (Fig. 1, memory 139) which stores at least one specific telephone number (col. 9 lines 26-43; col. 10 line 47 - col. 11 line 7). In light of the teaching from Harris, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the digital camera taught in Wakabayashi with a storage unit for storing phone numbers so as to allow the user to access desired phone numbers in an expedite manner.

As to claim 12, Wakabayashi, as modified by Harris, teaches a transmission unit which transmits the combination signal as an electromagnetic signal through the wireless telephone network, whereby the transmission unit is capable of transmitting the digital electronic signal indicative of a still image and the audio signal separately (Wakabayashi, Figs. 1, 3 and 4) (Harris col. 3 line 40 - col. 4 line 60, col. 9 lines 35-65).

As to claim 13, Wakabayashi, as modified by Harris, teaches a storage unit which stores the digital electromagnetic signal indicative of a still image from the converting unit, wherein the combination unit combines the digital electronic signal indicative of a still image stored in the storage unit with the electronic audio signal. (Harris, Fig. 1, memory 153, col. 3 line 41 -col. 4 line 60; col. 6 lines 25-49; col. 9 lines 35-65; col. 11 line 39 - col. 12 line 30).

As to claim 14, Wakabayashi teaches that the converting unit is capable of converting an optical image into a digital electronic signal indicative of a still image while the audio signal is transmitted by the transmission unit (Figs. 1-7).

As to claim 16, Wakabayashi teaches a microphone (22) for converting sound into an electronic audio signal, wherein the speaker (12) and the microphone have a first mode function in which they are used with the ear and the mouth of a user respectively

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close thereto (Fig. 5-7), and a second mode function in which they are used with the ear and the mouth of a user respectively remote therefrom (Figs. 1, 3 and 4).

As to claim 18, Wakabayashi teaches that the first converting unit is directed toward an object located at a position where the display unit is not observable (Fig. 3).

As to claim 19, Wakabayashi teaches that the first converting device unit is capable of being directed toward an object located at a position where the display unit is observable (Fig. 1).

Regarding claim 20, Wakabayashi teaches a digital still camera (1) capable of telecommunication comprising:

- a converting unit (camera 20) which converts an optical image into a digital electronic signal indicative of a still image;

- a microphone (22) for converting sound into an electronic audio signal;

- a selecting unit which selects one of the digital electronic signal and the electronic audio signal (Figs. 1-7);

- a first transmitter which transmits an electromagnetic signal through a wireless telephone network to designate a remote device having a telephone number (Figs. 1, 3 and 4);

- a second transmitter which transmits the signal selected by the selecting unit as an electromagnetic signal through the wireless telephone network containing to the designated remote device (Figs. 5-7); and

- a control unit which prevents the selecting unit from selecting the digital electronic signal when the telephone number designating the remote device coincides with the specific telephone number (Figs. 5-7).

Claim 20 differs from Wakabayashi in that the claim further requires a memory which stores at least one phone number. However, the limitation is well known in the art as shown in Harris '336. In the same field of endeavor, Harris '336 teaches a digital camera capable of telecommunication comprising a memory (Fig. 1, memory 139) which stores at least one specific telephone number (col. 9 lines 26-43; col. 10 line 47 - col. 11 line 7). In light of the teaching from Harris, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the digital camera taught in Wakabayashi with a storage unit for storing phone numbers so as to allow the user to access desired phone numbers in an expedite manner.

Regarding claim 21, Wakabayashi teaches a digital still camera (1) capable of telecommunication comprising:

- a converting unit (camera 20) which converts an optical image into a digital electronic signal indicative of a still image;

- a microphone (22) for converting sound into an electronic audio signal;

- a combination unit which combines the digital electronic signal with the electronic audio signal (Figs. 1, 3 and 4);

- a designation unit (10) which designates a remote device in a wireless telephone network with a specific phone number thereof,

- a first control unit which allows or prevent the combination unit from combining the digital electronic signal with the electronic signal when the specific phone number of the remote device coincides with the phone number stored in the storage unit (Figs. 5-7);

- a selecting unit (Figs. 1, 3 and 5) which selects one of the digital electronic signal indicative of the still image and the electronic audio signal;

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a transmitter which transmits the signal selected by the selecting unit as an electromagnetic signal containing the still image signal or the electronic audio signal through the wireless telephone network (Figs. 1, 3 and 5); and

a second control unit which prevents the selecting unit from selecting the digital electronic signal indicative of the still image unless the selection is requested by a manual operation (Figs. 1-7).

Claim 21 differs from Wakabayashi in that the claim further requires a storage unit which stores at least one phone number. However, the limitation is well known in the art as shown in Harris '336. In the same field of endeavor, Harris '336 teaches a digital camera capable of telecommunication comprising a memory (Fig. 1, memory 139) which stores at least one specific telephone number (col. 9 lines 26-43; col. 10 line 47 - col. 11 line 7). In light of the teaching from Harris, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the digital camera taught in Wakabayashi with a storage unit for storing phone numbers so as to allow the user to access desired phone numbers in an expedite manner.

Regarding claim 22, Wakabayashi teaches a digital still camera (1) capable of telecommunication, comprising:

a converting unit (camera 20) which converts an optical image into a digital electronic signal indicative of a still image;

a first transmitter which transmits an electromagnetic signal generated in accordance with a wireless telephone system to designate a remote device with a telephone number (Figs. 5-7);

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a second transmitter which transmits the digital electronic signal indicative of the still image as an electromagnetic signal generated in accordance with a wireless telephone system containing the still image (Figs. 1, 3 and 4); and

a device control unit which allows the transmission of the electromagnetic signal containing the still image when the telephone number designating the remote device coincides with the specific telephone number in the memory.

Claim 22 differs from Wakabayashi in that the claim further requires a storage unit which stores at least one phone number. However, the limitation is well known in the art as shown in Harris '336. In the same field of endeavor, Harris '336 teaches a digital camera capable of telecommunication comprising a memory (Fig. 1, memory 139) which stores at least one specific telephone number (col. 9 lines 26-43; col. 10 line 47 - col. 11 line 7). In light of the teaching from Harris, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the digital camera taught in Wakabayashi with a storage unit for storing phone numbers so as to allow the user to access desired phone numbers in an expedite manner.

4. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wakabayashi in view of Harris '336, as applied to claim 7 above, and further in view of Sugiyama et al. (US #5,510,829).

As to claims 8-9, the claim differs from Wakabayashi and Harris in that the claim further requires a device for inhibiting the speaker from generating the audio signal in the second mode, and a distinguishing unit which distinguishes an electromagnetic signal containing a still image signal from an electromagnetic signal containing an audio signal,

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to automatically control the switching unit. However, it is well known in the art to provide a communication apparatus which informs a user of receiving call from a video phone apparatus or a telephone with only an image in order to prevent a reception sound from disturbing a conference in progress, as taught in Sugiyama '829 (see col. 2 lines 31-40; col. 4 line 25 - col. 6 line 52). In light of the teaching from Sugiyama, it would have been obvious to one of ordinary skill in the art to allow the handheld video phone taught in Wakabayashi and Harris to receive only image data so as not to allow any reception sound to disturb any communication which is in progress.

5. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wakabayashi in view of Harris '336, as applied to claim 16 above, and further in view of Umezawa et al. (US #5,491,507).

As to claim 17, Wakabayashi, as modified by Harris, teaches a microphone for converting sound into an electronic audio signal, wherein the speaker and the microphone have a first mode function in which they are used with the ear and the mouth of a user respectively close thereto (see Wakabayashi, Figs. 5-7) (see Harris, Fig. 3). Wakabayashi teaches a second mode function in which they are used with the ear and the mouth of a user respectively remote therefrom (Fig. 1). Claim 17 differs from Wakabayashi and Harris in that the claim further requires a manual switch for activating the display unit, wherein the speaker and the microphone are automatically changed into the second mode when the display means is activated by the manual switch. However, for the purpose of having a privacy conversation using a video-telephone equipment it is well known in the art to use the microphone and the speaker remotely as shown in Umezawa '507 (col. 6

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line 15 - col. 7 line 39; col. 9 lines 17-29; col. 10 lines 32-54). Umezawa further teaches a manual switch for activating the display device wherein the speaker and the microphone are automatically changed into the second mode when the display device is activated by the manual switch (col. 16 line 47 - col. 18 line 36). In light of the teaching in Umezawa, it would have been obvious to one of ordinary skill in the art to modify the video-telephone equipment taught in Wakabayashi and Harris by providing a manual switch in the second mode function in which the microphone and the speaker are used remotely therefrom so as to allow the user to have a privacy conversation to a third party.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc-Yen T. Vu whose telephone number is 703-305-4946. The examiner can normally be reached on Mon. – Fri. from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy R. Garber can be reached on 703-305-4929. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


NGOC-YEN VU
PRIMARY EXAMINER

Art Unit 2612

NYV
08/05/2004